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JUL 22 2009

OFFICE OF PETITIONS

In re Application of :
Phillips et al. : DECISION ON APPLICATION
Application No. 09/615,021 : FOR
Filed: July 13, 2000 : PATENT TERM ADJUSTMENT
Atty Docket No. 35512-00033 :

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR §1.705," filed February 11, 2009. Applicants request that the initial determination under 35 USC 154(b) be increased from one thousand five hundred thirteen (1513) days to one thousand nine hundred fifty-six (1956) days.

The application for patent term adjustment is GRANTED to the extent indicated herein.

The Office has updated the PAIR screen to reflect that the Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is one thousand five hundred seventy-five (1575) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On February 2, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 1513 days. On February 11, 2009, applicants timely¹ submitted an application for patent term adjustment (with required fee). Applicants request entry of a period of adjustment of 381 days for the Office taking until

¹ PALM records indicate that the Issue Fee payment was received on February 11, 2009.

June 5, 2007 to mail a Notification of Noncompliant Appeal Brief in response to the Appeal Brief filed January 20, 2006. In addition, applicants request reinstatement of 62 days of reduction for applicant delay in filing a supplemental Appeal Brief on September 5, 2007.

The record supports a conclusion that the patent issuing from this application is not subject to a terminal disclaimer.

Applicants' arguments have been considered, but not found persuasive. There was no Office delay, within the meaning of 35 U.S.C. 154(b)(1)(A)(ii), in taking action in response to the date on which an appeal was taken in this application.

35 U.S.C. 154(b)(1)(A) provides, in pertinent part, that:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to -

...

(ii) respond to a reply under section 132, or to an appeal taken under section 134, within 4 months after the date on which the reply was filed or the appeal was taken;

37 CFR 1.702(a) provides, in pertinent part that subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(2) Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken;

However, as provided in 37 CFR 1.703(a), this period is calculated as:

(4) The number of days, if any, in the period beginning on the day after the date that is four months after the date an appeal brief in compliance with § 41.37 of this title was filed and ending on the date of mailing of any of an examiner's answer under § 41.39 of this title, an action

under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

Furthermore, as stated in the Final Rule²,

Section 1.703(a)(4) also pertains to the provisions of 35 U.S.C. 154(b)(1)(A)(ii). Section 1.703(a)(4) specifies that the period is the number of days, if any, beginning on the day after the date that is four months after the date an appeal brief in compliance with 1.192 was filed and ending on the mailing date of any of an examiner's answer under 1.193, an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first. As discussed below, the phrase "the date on which" an "appeal was taken" in 35 U.S.C. 154(b)(1)(A)(ii) means the date on which an appeal brief (and not a notice of appeal) was filed. The phrase "appeal brief in compliance with 1.192" requires that: (1) the appeal brief fee (1.17(c)) be paid (1.192(a)); and (2) the appeal brief complies with 1.192(c)(1) through (c)(9). (See also the Response to Comment 38).

Applicants are incorrect in calculating a period of adjustment for Office delay from the date of filing of a non-compliant Appeal Brief on January 20, 2006 to the mailing of a Notification of Non-compliant Appeal Brief on June 5, 2007. In this instance, the Appeal Brief filed January 24, 2006 (not January 20, 2006³) was non-compliant. An appeal brief in compliance with 1.192 was filed on July 5, 2007 and the Office took action in response on December 5, 2006 by mailing a notice of allowance. As this was within four months of the filing of the compliant appeal brief there was no Office delay within the meaning of the statute or the rules.

However, applicants are correct in noting that a period of reduction is not warranted for the filing of a supplemental

² See *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term*; Final Rule, 65 Fed. Reg. 56366 (September 18, 2000).

³ "[t]he date indicated on any certificate of mailing or transmission under § 1.8 shall not be taken into account in this calculation" of patent term adjustment. 37 CFR 1.703(f), See also, Comment 10, *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term*; Final Rule, 65 Fed. Reg. 54366 (September 18, 2000).

appeal brief on September 5, 2007. The period of reduction of 62 days is being removed.

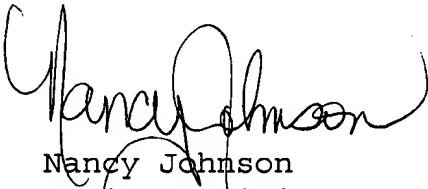
In view thereof, the determination of patent term adjustment at the time of the mailing of the Notice of Allowance is 1,575 days ((504 + 25 + 1086 days of Office delay) - (5 + 4 + 4 + 27 days of applicant delay)).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson", is written over the typed name.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of REVISED PALM Screen

Day : Tuesday
Date : 7/21/2009

PALM INTRANET

Time: 20:00:59

PTA Calculations for Application: 09/615021

Application Filing Date:	07/13/2000	PTO Delay (PTO):	1615
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	102
Post-Issue Petitions:	0	Total PTA (days):	1575
PTO Delay Adjustment:	62		

File Contents History

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91	06/03/2008	APPEAL AWAITING BPAI DOCKETING			
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87	02/11/2008	MAIL REPLY BRIEF NOTED BY EXAMINER			
86	02/11/2008	REPLY BRIEF NOTED BY EXAMINER			
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82	02/05/2008	REPLY BRIEF NOTED BY EXAMINER			
81	12/28/2007	MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT			
80	12/26/2007	MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT			

79	12/18/2007	RETURN OF UNDOCKETED APPEAL TO THE TC			
78	12/18/2007	EXAM. ANS. REVIEW COMPLETE			
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60	10/11/2006	CASE DOCKETED TO EXAMINER IN GAU			
59	09/08/2006	CORRESPONDENCE ADDRESS CHANGE			
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57	04/06/2006	MAIL SUPPLEMENTAL EXAMINER'S ANSWER			
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9	04/23/2002	CASE DOCKETED TO EXAMINER IN GAU			
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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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